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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,754	01/26/2004	Jan Willem Hellenthal	W. Hellenthal 1-2 (LCNT/1)	8766
46363 7590 11/27/2007 PATTERSON & SHERIDAN, LLP/ LUCENT TECHNOLOGIES, INC 595 SHREWSBURY AVENUE SHREWSBURY, NJ 07702			EXAMINER NGUYEN, VAN H	
			ART UNIT 2194	PAPER NUMBER
			MAIL DATE 11/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/764,754	Applicant(s) HELLENTHAL ET AL.	
	Examiner VAN H. NGUYEN	Art Unit 2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the amendments filed 09/14/2007.

Claims 1-7 and 17-19 are pending in this application. Claims 8-16 and 20 have been cancelled.

Claim Objection

2. Claims 1 and 17 are objected to because of the following minor informalities:
 - As to claim 1: "*the implementation parameters*" should read "*the service contract implementation parameters*"; and
 - As to claim 17: "*directs*" should read "*direct*".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 18, "said at least one request" lacks antecedent basis. It is noted that the term "at least one request" as previously recited in independent claim 17 has been deleted.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 17, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by **Bouret et al.** (Pub. No.: US 2002/0101879 A1).

As to claim 1:

An intended use of a claimed device does not limit the scope of the claim. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (product claim's intended use recitations not given patentable weight); see also

Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp., 320 F.3d 1339, 1345, 65 USPQ2d 1961, 1965 (Fed. Cir. 2003) ("An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates."). Although "[s]uch statements often... appear in the claim's preamble," *In re Stencel*, 828 F.2d 751, 754, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.*

Initially, it is noted that the claim limitation "*for communicating with a user device and for sending and receiving application programming interface commands*" is merely an intended use of the recited "*an open API server*". Also, the claim limitation "*a proxy for receiving application programming interface commands from the open API server, for sending the application programming interface commands received from the open API server to an application, for receiving responses from the application*" is merely an intended use of the recited "*a proxy*". Therefore, these limitations are not entitled to patentable weight. However, even if these limitations are given patentable weight they are met by Bouret.

Bouret teaches the invention as claimed including an apparatus [*see the Abstract and the discussion beginning at ¶0018*], comprising:

- an open API server (*e.g., The Parlay framework 2 can be seen as a collection of application programming interfaces*) for communicating with

a user device (*e.g., user 3*) and for sending and receiving application programming interface commands (*e.g., The APIs are typically used to provide functions*) [see the Parlay framework discussion beginning at ¶0036]; and

- a proxy (*e.g., proxy server 6*) for receiving application programming interface commands from the open API server, for sending the application programming interface commands received from the open API server to an application, for receiving responses from the application (*e.g., an application*), and for sending the received responses to the open API server [see the proxy server discussion beginning at ¶0036];
- wherein the proxy sends service contract implementation parameters (*e.g., service contracts*) to the open API server, wherein the implementation parameters sent to the open API server direct the open API server to implement local service contract terms [see the discussion at ¶¶0028, 0031, 0036, and 0044]; and
- wherein the open API server controls sending application programming interface commands based on the local service contract terms [see the discussion at ¶¶0052-0059].

As to claim 2:

Bouret teaches the service contract implementation parameters are related to a service contract (*e.g., service contracts*) [see ¶¶0028,0031,0036, and 0044]

As to claim 3:

Bouret teaches a database for storing control parameters, wherein the proxy accesses and processes the stored control parameters to form the service contract implementation parameters [see ¶¶0049-0059].

As to claim 4:

Bouret teaches a registration [see ¶¶0018-0020 and 0042-0054] and discovery device that receives control parameters, wherein the proxy processes the stored control parameters to form the service contract implementation parameters [see ¶¶0037-0040].

As to claim 5:

Bouret teaches the proxy includes input/output circuitry, a memory, and a processor [see the proxy server discussion beginning at ¶0042].

As to claim 6:

Bouret teaches a computer readable media for storing program information that at least partially controls the proxy to produce the service contract implementation

parameters *[see the proxy server discussion beginning at ¶0036]*.

As to claim 7:

Bouret teaches the at least one identified condition comprises a change in service usage *[see ¶¶0021, 0032-0033, and 0061]*.

As to claim 17:

The rejection of claim 1 above is incorporated herein in full. Additionally, Bouret further teaches obtaining service contract terms (*e.g., an agreement regarding the services*); processing the service contract terms to develop implementation parameters for a plurality of open API servers *[see ¶¶ 0044-0051]*; wherein each open API server sends said application programming interface commands in accordance with its local service contract terms *[see ¶¶ 0052-0059]*.

As to claim 19:

Bouret teaches storing obtained service contract terms *[see ¶¶0049-0051]*.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Bouret et al.** (Pub. No.: US 2002/0101879 A1) in view of **Reynolds et al.** (US 7225244 B2).

As to claim 18:

The combination of Bouret and Reynolds teaches identifying, at said one of said open API servers, a condition requiring modification of said at least one of said local service contract terms associated with said one of said open API servers; and sending said at least one request to modify said at least one of said local service contract terms (*Reynolds; see changing/modifying parameters discussion*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Bouret with Reynolds because Reynolds's teaching

would have allowed network operators to provide multiple advanced services, to more easily provide a wide variety of different and even competing services without being required to generate and/or maintain these services, and to use external services for connection management operations such as charging and intelligent network services.

Response to Arguments

6. Applicant's arguments filed 09/14/2007 have been fully considered but they are not persuasive.

Regarding independent claims 1 and 17

Applicant argued in substance that Bouret does not teach that a proxy sends service contract implementation parameters to an open API server, wherein the implementation parameters sent to the open API server direct the open API server to implement local service contract terms.

The examiner's response is as follows. Firstly, in the Office Action, the examiner mapped each claimed limitation to relevant passages in the Bouret reference to show how the reference meets the claim limitations. Applicant in response did not provide any underlying analysis as to why the portions of the prior art relied on did not support the examiner's position. Secondly, Bouret teaches a proxy sends service contract implementation parameters to an open API server, wherein the

implementation parameters sent to the open API server direct the open API server to implement local service contract terms [see ¶¶ 0052-0059].

Regarding dependent claims 2-7, 18, and 19

Applicant did not provide arguments in substance regarding claims 2-7, 18, and 19 except for citing the dependencies.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

8. Any inquiry or a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H. NGUYEN whose telephone number is (571) 272-3765. The examiner can normally be reached on Monday-Thursday from 8:30AM-6:00PM. The examiner can also be reached on alternative Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM THOMSON can be reached at (571) 272-3718.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Van H. Nguyen", with a large, sweeping initial "V" on the left.

VAN H. NGUYEN
PRIMARY EXAMINER